Decision for dispute CAC-UDRP-101171

Case number	CAC-UDRP-101171
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Domain names	generic-provigil.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	SRC Domain Service

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has extensive trademark rights in Class 5 in its PROVIGIL® mark. For purposes of this proceeding, Complainant relies on rights in the United States and Europe and provides evidence in that regard (U.S. Reg. Nos. 2000231; OHIM CTM Reg. No. 003508843).

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

BACKGROUND

The Complainant Cephalon, Inc. (“Cephalon”), is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. Formed in 1976, through its predecessors-in-interest, Teva Pharmaceutical Industries Ltd., together with its subsidiaries (collectively, “Teva”), was first established in 1901 with its global headquarters in Israel. Operating in sixty countries worldwide, Teva (NYSE and TASE: TEVA) (www.tevapharm.com) is ranked among the top pharmaceutical companies in the world, and the world’s largest generic medicines producer. Teva’s net revenues in 2014 amounted to $20.3 billion.

In specialty medicines, Teva has a world-leading position in innovative treatments for disorders of the central nervous system, including pain, as well as a strong portfolio of respiratory products.

Cephalon's PROVIGIL® (modafinil) Tablets [C-IV] are part of Teva's CNS (Central Nervous System) line of specialty medicines. They contain modafinil, a Schedule IV federally controlled substances in the United States. Subject to important safety information, PROVIGIL® is indicated to improve wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnea (but not as treatment for the underlying obstruction), or shift work disorder.

The Complainant claims the PROVIGIL® mark is well known within its specialty area.

Furthermore, the Complainant contends several CAC Panels have recognized Cephalon's rights in its PROVIGIL/NUVIGIL marks. CAC Case Nos. 100832-100835 (transferring, amongst others, <provigilmodafinilforsale.com>, <provigilonline.com>, <provigil4bitcoins.com>, <genericprovigil.net>, <buy-provigil-generic.com>, etc.); see also CAC Case No. 100892 (transferring <buyprovigil-quick.com>, <buyprovigilextra.com>, <buyprovigilmeds.com>, <provigilforsale.com>, among others).

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

CONFUSING SIMILARITY

According to the Complainant the disputed domain name is confusingly similar to the registered trademarks in which Complainant has rights for they are fully incorporated in the disputed domain name.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant claims the Respondent has not been commonly known by the disputed domain name, and, further, the Complainant has not authorized, permitted or licensed the Respondent to use its trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever.

The Complainant claims and provides evidence the Respondent is luring consumers in search of the well-known PROVIGIL brand to a documented rogue online pharmacy that promotes substitute products, including among others, MODALERT, arguably competitive to the PROVIGIL brand. Such use does not demonstrate a legitimate right or interest.

BAD-FAITH REGISTRATION AND USE

The trademarks registration rights predate the domain name registration, and the allegations that the trademarks are well-known in their field have not been rebutted. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name, as obviously also follows from the way the domain name is currently being used.

In light of the use of the disputed domain name as evidenced by the documents submitted by the Complainant, the Respondent is attempting to attract, for commercial gain, Internet users to its web site or to the web sites linked thereto, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of their web sites and of the products promoted therein. Therefore, the Complainant concludes the requirement of bad faith registration and use of the disputed domain name pursuant to article 4(a)(iii) of the Policy has been met.

PARTIES CONTENTIONS

RESPONDENT:

The Respondent did not respond to the Complainant at all even it is obliged to do so.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The main issues under the UDRP are whether:

i. the domain name in dispute is identical or confusingly similar to a domain name or a trademark or service mark in which the Complainant has rights; and

ii. the Respondent has no rights or legitimate interests with respect to the domain name; and

iii. the domain names has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Panel also visited all available websites and public information concerning disputed domain name, namely the WHOIS database and related trademark register databases.

3. The Uniform Domain Names Dispute Resolution Policy in its paragraph 4 defines what has to be understood as an evidence of the registration and use of the domain name in bad faith.

Particularly paragraph 4(b)(iv) of the Policy has to be considered in this case.

The Rules for Uniform Domain Name Dispute Resolution Policy clearly stipulate in paragraph 3 that any person or entity may initiate an administrative proceeding by submitting a Complaint in accordance with the Policy describing according to para (ix), sub para (iii) why the domain name(s) should be considered as having been registered and being used in bad faith.

4. The panel therefore came to the following conclusions:

a) The Complainant has clearly proven that it has long standing rights in the mark “PROVIGIL” and its variations. The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interest in respect of the disputed domain names and as the Respondent was never authorized to use the domain names by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant has not licenced or otherwise permitted the Respondent to use Complainant´s marks in the disputed domain names. On the basis of evidence submitted and in the absence of Response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Domain names to be identical or confusingly similar

b) It is also clear and proven that there is a similarity between some trademarks of the Complainant and the disputed domain name as to the phonetic similarity, optical similarity; conceptual/intellectual similarity. It is constantly decided not only in proceedings at this body but also at WIPO that adding a letter, number, any figure, prefix or a an added part of the domain name to the original trademark is not enough to make a distinction to another original trade mark and/or domain name.

Respondent not having rights or legitimate interest with respect to the disputed domain name

c) It has to be emphasized that it was proven by documents delivered by the Complainant and from the factual situation on the internet verified by the Panel that there is no legitimate interest or right of the Respondent in the disputed domain name.

Domain name has been registered and is used in bad faith

d) It was proven that the Respondent has registered the disputed domain names only after the confusingly trademarks of the Complainant had been registered and properly used for a long time in business.

e) It is therefore clear that there is a high probability of a speculative behaviour of the Respondent. On top of that it was not proven that the owner of the disputed domain name is active in business and therefore this based on the previous decision and practice of the arbitrators may lead to the conclusion that the use of the disputed domain name is speculative by the Respondent.

f) Therefore it has to be concluded that the Respondent has registered/acquired the disputed domain name primarily for the purpose of his own benefit when disrupting the business of the Complainant and therefore the Respondent is using the domain name in a bad faith. The domain name shall be transferred to the Complainant without a delay.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **GENERIC-PROVIGIL.COM**: Transferred

PANELLISTS

Name	**Dr. Vít Horáček**

DATE OF PANEL DECISION 2016-04-04

Publish the Decision